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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/682,546

10/10/2003

K. M. Slimak

TPP 31413DIV

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02/22/2010

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EXAMINER

WINSTON, RANDALL O

ART UNIT

PAPER NUMBER

1655

MAIL DATE

DELIVERY MODE

02/22/2010

PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* K.M. SLIMAK

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Appeal 2009-007992<sup>1</sup>  
Application 10/682,546  
Technology Center 1600

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Decided: February 22, 2010

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Before TONI R. SCHEINER, DONALD E. ADAMS, and LORA M. GREEN,  
*Administrative Patent Judges.*

SCHEINER, *Administrative Patent Judge.*

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 1, 2, 4-7, 9-14, and 17-20,<sup>2</sup> directed to a method for dietary intervention. The claims have been rejected as lacking enablement. We have jurisdiction under 35 U.S.C. § 6(b).

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<sup>1</sup> Heard February 2, 2010.

<sup>2</sup> Claims 15 and 16 are also pending but have been withdrawn from consideration. Claims 3 and 8 have been canceled. (App. Br. 2.)

## STATEMENT OF THE CASE

Claim 1 is representative of the subject matter on appeal:

1. A method for dietary intervention, said method comprising:
  - (a) withholding all food from an animal for at least 5 days, except for tropical root crops; and
  - (b) feeding a concentrated form of tropical root crops to the animal for at least the five day period.

The Examiner relies on the following evidence:

Slimak	US 5,789,012	Aug. 4, 1998
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The Examiner rejected claims 1, 2, 4-7, 9-14, and 17-20 under 35 U.S.C. § 112, first paragraph, as lacking enablement.

We reverse.

## ENABLEMENT

### *Issue*

According to the Examiner, “the specification does not enable any person in the art in preparing a method for a dietary intervention of treating any and/or all chronic diseases, conditions and symptoms” other than those “reasonably demonstrated . . . [in] examples III-VI of the specification” (Ans. 4), and “it would require undue experimentation for one of skill in the art to practice the invention commensurate in scope with the claims (*id.* at 6).

Appellant contends that the claims are not directed to “a method for treating certain diseases, symptoms or conditions,” but to “a dietary intervention plan” (App. Br. 4), “which is clearly supported and enabled by the original disclosure” (*id.* at 3).

The issue raised by this rejection is: Has the Examiner established that undue experimentation would have been required to practice the *claimed* method, specifically, a method for dietary intervention?

*Findings of Fact*

FF1 The Specification teaches that the claimed method of dietary intervention can be used to accomplish a number of objectives. For example, the claimed method can be used to identify food allergies, sensitivities and intolerances not accurately identified or even detected by conventional immunological tests (Spec. 3).

FF2 In addition, the Specification teaches that the claimed method can be used to distinguish between symptoms associated with foods and those associated with environmental sources such as pollen, mold, pets, and chemicals (Spec. 4).

*Principles of Law*

“[T]he PTO bears an initial burden of setting forth a reasonable explanation as to why it believes that the scope of protection provided by [the] claim[s] is not adequately enabled by the description of the invention provided in the specification of the application” *In re Wright*, 999 F.2d 1557, 1561-62 (Fed. Cir. 1993).

“[T]o be enabling, the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without ‘undue experimentation.’” *Id.* at 1561. However, the enablement analysis must be focused on the product or method defined by the claims. “Title 35 does not require that a patent disclosure enable one of ordinary skill in the art to make and use a perfected, commercially viable embodiment absent a claim limitation to that effect.” *CFMT, Inc. v. Yieldup Int’l Corp.*,

349 F.3d 1333, 1338 (Fed. Cir. 2003). *See also In re Cortright*, 165 F.3d 1353, 1359 (Fed. Cir. 1999) (claims to method of “restoring hair growth” encompassed achieving full head of hair but did not require it).

*Analysis*

The claims are directed to “[a] method for dietary intervention” (e.g., claim 1). According to the Examiner, “the term ‘dietary intervention’” should be interpreted “to mean to provide the diet as claimed for the specification-disclosed use of treating a particular condition or symptom from a very long list of conditions and symptoms” (Ans. 7) because the Specification “does not teach any other use for the dietary intervention” (*id.* at 8).

The Examiner concluded that the Specification is enabling for treating conditions and symptoms “reasonably demonstrated” in the Specification’s working examples (Ans. 4), but “it would require undue experimentation . . . to practice the invention commensurate in scope with the claims” (*id.* at 6) because the Specification doesn’t “provide guidance or working examples, or overcome the unpredictable art . . . to treat any and/or all chronic diseases, conditions and symptoms” (*id.* at 8).

Appellant contends that the claims are not directed to “a method for treating certain diseases, symptoms or conditions,” but to “a dietary intervention plan” (App. Br. 4), “which is clearly supported and enabled by the original disclosure” (*id.* at 3). Appellant contends that “the application [has not been] examined to see if enabling disclosure is found for the specified steps of applicant’s claims” (*id.* at 4).

Appellant’s argument is persuasive. It’s true that the Specification contemplates the use of the claimed dietary intervention method to treat

various diseases, conditions and symptoms. Nevertheless, the Specification also contemplates dietary intervention for several other purposes, e.g., for identifying food allergies, sensitivities and intolerances not accurately identified or even detected by conventional immunological tests, and distinguishing between symptoms associated with foods and symptoms associated with environmental sources (FF1, FF2). In short, the claims at issue are not directed to treatment of any particular disease, condition, or symptom, or indeed to treatment of any kind, and practicing the claimed method does not require a therapeutically effective result. Therefore, we agree with Appellant that the Examiner has not addressed the enablement of the invention that *is* claimed.

*Conclusions of Law*

The Examiner has not established that undue experimentation would have been required to practice the claimed method, specifically, the claimed method for dietary intervention. The claims do not require therapeutically effective treatment of any disease, and the Examiner erred in concluding that such an effect was required to satisfy 35 U.S.C. § 112, first paragraph.

The rejection of claims 1, 2, 4-7, 9-14, and 17-20 under 35 U.S.C. § 112, first paragraph, as lacking enablement is reversed.

REVERSED

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